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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GODDARD, BRIAN D

ART UNIT

PAPER NUMBER

2161

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/943,524

Applicant(s)

HENKIN ET AL.

Examiner

Brian Goddard

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is responsive to the Amendment filed 18 January 2005.
2. Claims 1-78 are pending in this application. Claims 1, 33, 41 and 69 are independent claims. In the Amendment filed 18 January 2005, claims 75-78 were added, and claims 1, 6, 7, 8, 18, 24, 30, 33, 34, 36, 37, 41, 43, 45, 55, 61, 62, 67, 69, 70, and 72 were amended. This action is made Final.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-3, 6-16, 19-42, 45-53 and 56-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,141,010 to Hoyle in view of U.S. Patent No. 6,862,710 to Marchisio.

Referring to claim 1, Hoyle discloses a method for generating markup information to be displayed on a client computer system substantially as claimed. See Figures 1-14 and the corresponding portions of Hoyle's specification for this disclosure. Specifically, Hoyle teaches a method [See Figs. 10-12] for generating markup information [banner advertisements inserted into markup language (e.g. HTML) documents (See Figs. 1-5)] to be displayed on a client computer system [18], the client system including memory [See column 7, lines 14-26] configured to store at least one update file [130 (See Fig. 7)], the at least one update file including keyword information [category identifiers and

keywords (See column 16, lines 1-8)] relating to keywords suitable for markup, the method comprising:

analyzing [See Fig. 12] selected information associated with a first document [text located within a web page] for selected keywords [See above and Column 16, lines 1-8)], the first document being displayed on the client system to an end user [See Figs. 11-12];

the selected keyword information being provided by an entity other than the end user [See Figs. 7 & 11-12 and Column 16, lines 1-8];

selecting, using the selected keyword information, specific text in the first document to be marked up [a banner advertisement is selected (See Fig. 7 & step 224)];

performing, at the client computer system, markup operations on at least a portion of said selected specific text [Step 224].

Hoyle does not expressly teach that the selected specific text in the first document to be marked up is "contextually associated with at least a portion of the selected keyword information" as claimed. However, Marchisio discloses a system and method similar to that of Hoyle, wherein specific text in a document that is contextually associated with selected keyword information [selected keyword(s) within the document] is marked up with a link to another document [soft hyperlink]. See the Abstract, Summary, Figures 1-11 and the corresponding portions of Marchisio's specification for this disclosure.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add Marchisio's soft hyperlink markup functionality to Hoyle's system and method so as to mark up additional keywords in Hoyle's documents with links to corresponding banner ads, to obtain the invention as claimed. One would have been motivated to do so in order to provide the user with access [via the soft hyperlink] to as much additional information he/she may be interested in as possible, without detracting from the original document or distracting the user, as disclosed by Marchisio.

Referring to claim 2, the combination of Hoyle and Marchisio (hereinafter "Hoyle/Marchisio") discloses the method for generating markup information as claimed. See Figures 1-12 and the corresponding portions of Hoyle's specification for this disclosure. Hoyle/Marchisio teaches the method of claim 1, as above, wherein said method is performed locally at the client computer system [by the ADM Module (14) Client Software Application (10)] as claimed.

Referring to claim 3, Hoyle/Marchisio teaches the method of claim 1, as above, further comprising:

retrieving [Steps 212 & 218] the first document [web page (also 'information resource')] from an initial source [e.g. server];

storing said retrieved first document locally [web page is loaded and stored in browser's cache] at the client system; and

wherein said analyzing [See above] is performed on the stored first document in real-time [See column 6, lines 1-5 and column 16, lines 24-52] at the client system as claimed.

Claims 6-8 are rejected on the same basis as claim 2. See the discussions regarding claims 1-2 above, and the portions of Hoyle and Marchisio cited therein, for the details of this disclosure.

Referring to claim 9, Hoyle/Marchisio discloses the method for generating markup information as claimed. See Figures 13-14 and the corresponding portions of Hoyle's specification for this disclosure. Hoyle/Marchisio teaches the method of claim 1, as above, further comprising downloading [Step 184] said keyword information [See column 7, lines 52-58; column 8, lines 37-41; & column 12, lines 5-9] from a remote server system [ADM server 22] at periodic intervals as claimed.

Referring to claim 10, Hoyle/Marchisio discloses the method for generating markup information as claimed. See Figures 1-5 and the corresponding portions of Hoyle's specification for this disclosure. Hoyle/Marchisio teaches the method of claim 1, as above, wherein the markup operations [See above] result in marked up document context which has a visual appearance different than its initial parsed appearance [with the addition of a banner advertisement and soft hyperlinks] as claimed.

Referring to claim 11, Hoyle/Marchisio teaches the method of claim 10, as above, wherein the marked up document context [e.g. banner advertisement and soft hyperlink] includes a link [Hoyle: Destination Link (See Fig. 7 & Steps 192-194)] based on information included in the at least one update file [See Fig. 7] as claimed.

Referring to claims 12-13, Hoyle/Marchisio discloses the method for generating markup information as claimed. See Figure 3 and the corresponding portion of Hoyle's specification for this disclosure. Hoyle/Marchisio teaches the method of claim 10, as

above, wherein the marked up document context corresponds to keywords selected by [assigned to (See column 8, lines 44-52)] a campaign provider ['advertising distribution organization' 50 (See column 8, lines 44-52)] or an advertiser ['advertisers themselves' 50 (See column 8, lines 44-52)] as claimed.

Referring to claims 14 and 15, Hoyle/Marchisio discloses the method for generating markup information as claimed. See the discussion regarding claim 3 above for the details of this disclosure. Specifically, Hoyle/Marchisio's first document [web page (also 'information resource')] corresponds to a web page or frame in a web page retrieved from an information provider's [e.g. server] web page/site [See also Background & Summary] as claimed.

Referring to claim 16, Hoyle/Marchisio discloses the method for generating markup information as claimed. See Figures 1-5 & 10-11 and the corresponding portions of Hoyle's specification for this disclosure. Hoyle/Marchisio teaches the method of claim 1, as above, further comprising displaying [See Steps 212 & 218] at least a portion of the first document to the end user via a browser application ['Default Browser'] as claimed.

Referring to claims 19-20, Hoyle/Marchisio teaches the method of claim 1, as above, wherein the update file includes restriction information [See column 15, lines 1-67] specifying at least one restricted source location ['trigger link']... wherein the restricted source corresponds to a particular Internet domain name [base URL] as claimed.

Referring to claims 21-22, Hoyle/Marchisio teaches the method of claim 1, as above, wherein the update file includes restriction information [See column 15, lines 54-67] specifying a maximum number of markups per page ['maximum number of permitted displays']...and a maximum number of markups per repeat keyword [max 'frequency' of banner display]...as claimed.

Referring to claim 23, Hoyle/Marchisio discloses the method for generating markup information as claimed. See Figures 7-12 and the corresponding portions of Hoyle's specification for this disclosure. Hoyle/Marchisio teaches the method of claim 1, as above, wherein at least one keyword corresponds to a text string [category name or keyword (See Fig. 7)] which includes multiple words [number of keywords] as claimed.

Claims 24-25 are rejected on the same basis as claims 21-22. See the discussions regarding claims 1 and 21-22 above for the details of this disclosure.

Referring to claim 26, Hoyle/Marchisio discloses the method for generating markup information as claimed. See Figures 7 & 11-12 and column 12, line 27 – column 13, line 10 of Hoyle's specification, as well as Figures 9-10 and the corresponding portions of Marchisio's specification for this disclosure. Hoyle/Marchisio teaches the method of claim 1, as above, further comprising displaying a pop-up layer [Hoyle: pop-up notes or pop-up new browser window; Marchisio: See Figs. 9-10] on the client system in response to the user selecting a marked up portion of a first portion of document context [Steps 192 & 208];

wherein the pop-up layer includes information relating to an initial link [destination link] associated with the first portion of document context; and

wherein the pop-up layer includes information relating to a different link [new banner advertisements which are displayed based on the invention] which was not associated with the first portion of document context [original document or web page] as claimed.

Claim 27 is rejected on the same basis as claim 26. See the discussion regarding claim 26 above, and the portions of Hoyle's specification cited therein, for the details of this disclosure.

Referring to claim 28, Hoyle/Marchisio discloses the method for generating markup information as claimed. See Figures 7-12 and the corresponding portions of Hoyle's specification for this disclosure. Hoyle/Marchisio teaches the method of claim 1, as above, further comprising:

logging, on the client system [See column 11, lines 53-57 & Fig. 10], tracking information ['computer usage information'];

said tracking information including at least one of the following portions of information:

information relating to impressions, marked up keywords, or keywords clicked by the end user during a specified time interval [See Step 182].

Referring to claim 29, Hoyle/Marchisio discloses the method for generating markup information as claimed. See Figure 10 and the corresponding portion of Hoyle's specification for this disclosure. Hoyle/Marchisio teaches the method of claim 28, as above, further comprising periodically reporting [Step 182] said logged tracking

information ['computer usage information'] to a remote server system [ADM Server 22] for analysis and processing as claimed.

Claims 30-31 are rejected on the same basis as claim 29. See the discussions regarding claims 28-29 above, as well as the portions of Hoyle's specification cited therein, for the details of this disclosure.

Claim 32 is rejected on the same basis as claim 1. See the discussion regarding claim 1 above for the details of this disclosure.

Claim 33-36 and 40 are rejected on the same basis as claim 26. See the discussions regarding claims 1 and 26 above, and the portions of Hoyle and Marchisio cited therein, for the details of this disclosure.

Claims 37-39 are rejected on the same basis as claims 6, 14 and 15 respectively, in light of the basis for claim 33 above. See the discussions regarding claims 1, 6, 14, 15, 26 and 33 above for the details of this disclosure.

Claim 41 is rejected on the same basis as claim 1. See the discussion regarding claim 1 above for the details of this disclosure. In particular, Hoyle/Marchisio teaches "a system [Hoyle: See Figs. 1-4] for generating markup information to be displayed on a client computer system [18], the system comprising:

at least one processor [See column 7, lines 1-26];

at least one interface [32] configured or designed to provide a communication link [20] to at least one other network device [22] in a data network; and

memory [30, 34 (See column 7, lines 1-26)];

said at least one processor being configured to...[See Claim 1 above]" as claimed.

Claims 42, 45-53 and 56-68 are rejected on the same basis as claims 3, 7, 9-16 and 19-31 respectively, in light of the basis for claim 41 above. See the discussions regarding claims 1, 3, 7, 9-16 and 19-31 above for the details of this disclosure.

Claims 69-74 are rejected on the same basis as claims 33-36 and 38-39 respectively. See the discussions regarding claims 33-36 and 38-39 above for the details of this disclosure.

Claims 75-76 are rejected on the same basis as claim 26, in light of the basis for claim 33. See the discussions regarding claims 1 and 26 above, as well as the portions of Hoyle and Marchisio cited therein, for the details of this disclosure.

Claims 77-78 are rejected on the same basis as claim 26, in light of the basis for claim 69. See the discussions regarding claims 1 and 26 above, as well as the portions of Hoyle and Marchisio cited therein, for the details of this disclosure.

4. Claims 4-5, 17-18, 43-44 and 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyle in view of Marchisio as applied to claim 1 above, and further in view of U.S. Patent No. 6,098,065 to Skillen et al.

Referring to claim 4, Hoyle/Marchisio's analysis does not explicitly include a fuzzy search for selected keywords in the selected text as claimed. However, Hoyle's analysis does include topical/categorical analysis of the selected text to determine if it falls in a specific category. See Figure 7 and the discussion of Step 222 for the details

Art Unit: 2161

of this disclosure. This provides direct suggestion for using fuzzy search techniques to find inexact matches of keywords in the selected text, in order to categorize the selected text without necessity of an exact match (which is highly unlikely).

Skillen discloses a system and method similar to those of Hoyle and Marchisio, in which fuzzy search techniques are performed [See column 4, lines 14-25 and column 5, lines 29-38] for selected keywords ['search argument'] in the selected text, the fuzzy search being implemented such that a match will be found to occur despite lack of an exact match [non-precise matching] of the selected keywords within the context of the first document [e.g. web page] as claimed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add Skillen's fuzzy search logic to Hoyle/Marchisio so as to provide the combination with fuzzy search capability in searching for the keyword(s) or categories for displaying the advertising. One would have been motivated to do so because of the direct suggestion provided by Hoyle, as described above.

Referring to claim 5, the system and method of Hoyle in view of Marchisio and Skillen as applied to claim 4 above (hereinafter "Hoyle/Marchisio/Skillen") discloses the invention as claimed. See column 6, lines 20-44 of Skillen's specification for this disclosure. Skillen's fuzzy search, as applied to Hoyle/Marchisio above, is implemented such that a match will be found to occur if a percentage of the selected keywords ['search argument(s)'] identified in the context of the first document exceeds a predetermined match threshold percentage value [See column 6, lines 20-44] as claimed.

Referring to claims 17 and 18, Hoyle/Marchisio/Skillen discloses the invention as claimed. See the Background & Summary of Skillen's specification for this disclosure. Skillen's fuzzy search logic, as applied to Hoyle/Marchisio above, uses negative word filtering [using fuzzy search for keywords in conjunction with the 'NOT' operator] to exclude markups of selected document text [See above] as claimed.

Claims 43-44 are rejected on the same basis as claims 4-5 respectively, in light of the basis for claim 41 above. See the discussions regarding claims 1, 4-5 and 41 above for the details of this disclosure.

Claims 54-55 are rejected on the same basis as claims 17-18 respectively, in light of the basis for claim 41 above. See the discussions regarding claims 1, 17-18 and 41 above for the details of this disclosure.

Response to Arguments

5. Applicants' arguments with respect to claims 1-78 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. Specifically, the cited U.S. Patents not relied upon above are considered particularly pertinent to applicants' claimed invention as amended.

Art Unit: 2161

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Goddard whose telephone number is 571-272-4020. The examiner can normally be reached on M-F, 9 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2161

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bdg
10 May 2005


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